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In re Application of SAUER et al	:	
U.S. Application No.: 09/446,128	:	DECISION ON
PCT Application No.: PCT/EP98/03349	:	
Int. Filing Date: 04 June 1998	:	RENEWED PETITION
Priority Date: 04 July 1997	:	
Attorney Docket No.: A-6865	:	UNDER 37 CFR 1.47(a)
For: PROCESS FOR FURTHER PROCESSING	:	
OF SMALL GLASS PARTICLES	:	

This is in response to applicants' "Renewed Petition Under 37 CFR §1.47(a)" and "Supplement to Renewed Petition Under 37 CFR §1.47(a)" filed 04 April 2001, requesting that the present application be accepted for national stage processing without the signature of joint inventor Sarolf Sauer. In addition, this decision is responsive to applicants' "Revocation of Power of Attorney / Appointment of New Power of Attorney" filed 20 March 2001.

BACKGROUND

On 04 June 1998, applicants filed international application PCT/EP98/03349, which claimed priority of an earlier German application filed 04 July 1997. A Demand for international preliminary examination, in which the United States was elected, was filed on 04 January 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 January 2000.

On 28 December 1999, applicants filed national stage papers in the United States including, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 03 March 2000, the United States Designated/Elected Office mailed a "Notification of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 03 April 2000, applicants filed a petition requesting that the present U.S. national stage application be accepted without the signature of joint inventor Sauer. The petition was

accompanied by the requisite petition fee, a declaration signed by joint inventor Christian Klepsch, and the appropriate surcharge under 37 CFR 1.492(e) for the late declaration filing.

On 28 June 2000, the PCT Legal Office of the USPTO dismissed the 03 April 2000 petition on grounds that it failed to demonstrate that a bona fide attempt was made to present a copy of the application papers to Sauer at his last known address and for a lack of sufficient evidence of Sauer's purported refusal to sign.

On 04 August 2000, applicants filed a renewed petition under 37 CFR 1.47(a). The petition was accompanied by a letter signed by Sauer which purportedly demonstrates Sauer's express refusal to sign the declaration.

On 08 November 2000, the PCT Legal Office of the USPTO dismissed the 04 August 2000 petition on grounds that it failed to demonstrate that a bona fide attempt was made to present a copy of the application papers to Sauer.

On 04 April 2001, applicants filed the present renewed petition and a supplement to the present renewed petition. The renewed petition states that it is accompanied by the affidavit of Michael Babeluk.

DISCUSSION

I. Renewed Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventor, (2) factual proof that the missing joint inventor refuses to join in the application or cannot be reached after diligent effort, (3) the fee set forth in 37 CFR §1.17(i), and (4) the last known address of the nonsigning joint inventor. See 37 CFR 1.47(a).

With regard to item (1), the declaration filed 03 April 2000 is executed by joint inventor Klepsch on his own behalf and on behalf of joint inventor "Saroff Sauer". However, the given name "Saroff" does not match that shown on the international application. Therefore, the declaration is improper.

With regard to item (2), MPEP 409.03(d) states,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. . . .

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by

counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

In the present case, the affidavit of Michael Babeluk states that Mr. Babeluk sent a complete copy of the application papers to Sauer on 12 February 2001 (see paragraph 3 of Babeluk's affidavit and the copy of the letter dated 12 February 2001 attached to Babeluk's affidavit). The copy of the letter dated 19 February 2001 signed by Dr. Ingrid Weiss indicates that Sauer received the 12 February 2001 communication, including the application papers (see the copy of the letter dated 19 February 2001 attached to Babeluk's affidavit). Thus, applicants have sufficiently established that Sauer was presented with a complete copy of the application papers.

Applicants have also established with reasonable certainty that Sauer refuses to join in the application. Specifically, the letter signed by Sauer dated 21 July 2000 in which Sauer states, "Hereby, I do declare that I refuse to sign the declarations as requested. . . ." constitutes an express written refusal to sign the application papers.

With regard to item (3), applicants have submitted the fee required by 37 CFR 1.17(i).

With regard to item (4), applicants have provided the last known address of the nonsigning inventor.

II. Revocation and Appointment of Attorney

MPEP 402.07 states in relevant part,

A power of attorney by the assignee of the entire interest revokes all powers given by the applicant and prior assignees if the assignee establishes their right to take action as provided in 37 CFR 3.73(b). See MPEP § 324. . . .

In an application which has been accorded status under 37 CFR 1.47(a), or for which status under 37 CFR 1.47(a) has been requested, a power of attorney given by the inventors who have signed the declaration (available inventors) may be revoked by an assignee of the entire interest of the available inventors.

According to 37 CFR 3.73(b), ownership of the application may be established by: (A) submitting documentary evidence of a chain of title from the original owner to the assignee; or (B) specifying by reel and frame number where such evidence is recorded in the USPTO. In the present case, applicants have specified by reel and frame number three purported assignment documents which are recorded in the USPTO. The assignment document recorded at Reel 10693, Frame 244, sufficiently establishes that KGT-Klepsch Glastechnologie GmbH has assigned its interest to Starshine Glastechnologie GmbH. However, English language translations of the purported assignment documents recorded at Reel 10478, Frame 992, and at Reel 10479, Frame

001 have not been provided. See 37 CFR 3.26. Therefore, the chain of assignment from the inventors Sauer and Klepsch to Starshine Glastechnologie GmbH has not been established. Thus, it would not be appropriate to accept the "Revocation of Power of Attorney / Appointment of New Power of Attorney" at the present time.

CONCLUSION

Because applicants have failed to satisfy item (1) as discussed in §I above, the renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

Because applicants have not submitted a translation of the Annexes to the International Preliminary Examination Report within the time period set forth in paragraph 4 of the Notification of Missing Requirements, such Annexes are considered canceled. See 37 CFR 1.495(e).

If reconsideration on the merits of this decision is desired, a proper response, including a proper declaration, must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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